



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST-NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,010	09/13/2000	Joseph T. Pych	NMC-001.01	8285

25181 7590 04/07/2005

FOLEY HOAG, LLP
PATENT GROUP, WORLD TRADE CENTER WEST
155 SEAPORT BLVD
BOSTON, MA 02110

EXAMINER

KALINOWSKI, ALEXANDER G

ART UNIT	PAPER NUMBER
----------	--------------

3626

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/661,010

Applicant(s)

PYCH, JOSEPH T.

Examiner

Alexander Kalinowski

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 9-11, 15, 17, 18, 29-31, 35, 37, 38 and 45-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-8, 12-14, 16, 19-28, 32-34, 36, and 39-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-8, 12-14, 16, 19-28, 32-34, 36, and 39-44 are presented for examination.

Specification

2. The attempt to incorporate subject matter into this application by reference to copending applications on page 7 of the specification is improper because Applicant failed to provide the Application numbers of the co-pending applications. Correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8, 12-14, 16, 19-28, 32-34, 36, and 39-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over VALEX User Guide (hereinafter Valex) in view of Resnick, Rosalind, "Netcreations releases Postmaster Direct Response 2.0 Real-Time List Ordering System for the Web) (hereinafter Netcreations).

As to claim 1, Valex discloses A method of acquiring a list of prospective customers over a computer network, the prospective customer list including one or more attributes for each prospective customer on the list, the method comprising:

Art Unit: 3626

receiving a location of the list on the computer network from a client system (i.e. configuring query and table selection)(Chapter 1) ,
retrieving the list from the location (Chapter 1)
formatting the list for storage in a database of prospective customer lists (i.e. extract)(chapter 2 and Fig. 2-2), the formatting facilitating searching and retrieval of the list and data included therein from the database (chapter 2) and
Valex does not explicitly disclose
storing the formatted list in the database of prospective customer lists.

However, Netcreations discloses storing the list with prospective customer lists (I,e, offers more than 3000 lists)(page 1). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Netcreations within Valex for the motivation of offering automated realtime list availability to list purchasers (page 1)

As to claim 2, Valex discloses The method of claim 1 further comprising receiving from the client system descriptive data concerning the list, and storing the descriptive data in the database (page 2-10).

As to claim 3, Valex discloses The method of claim 2. wherein the descriptive data comprises at least one of
a name for the list, a description of the attributes included in thee list, and a privacy policy for the list (page 2-10).

As to claim 4, Valex discloses The method of claim 1, wherein formatting comprises

Art Unit: 3626

identifying the attributes included in the list received from the client system (page 2-10 and page 2-13-2-20),

comparing the identified attributes with database attributes, each database attribute being pre-defined by the database of prospective customer lists and having a predefined format (page 2-10 and page 2-13-2-20).

As to claim 5, Valex discloses The method of claim 4, further comprising transforming the format of an identified attribute into the format of a database attribute if a match is determined between an identified attribute and a database attribute (page 2-10 and page 2-13-2-20).

As to claim 6, Valex discloses The method of claim 4, further comprising creating a new database attribute for an identified attribute if no match is determined between the identified attribute and a database attribute (page 2-10 and page 2-13-2-20).

As to claim 7, Valex discloses The method of claim 6, wherein creating a database attribute comprises specifying the name and the type of the new database attribute (page 2-10 and page 2-13-2-20).

As to claim 8, Valex discloses The method of claim 1, wherein formatting comprises analyzing one or more attributes of the list to determine, for each attribute, the range of data values for the attribute (pages 1-29 –1-30).

As to claim 12, Valex does not explicitly disclose The method of claim 1. further comprising publishing the availability of the list from the database for purchase by a list purchaser.

However, Netcreations discloses publishing the availability of the list from the database for purchase by a list purchaser (page 1). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Netcreations within Valex for the motivation of offering automated realtime list availability to list purchasers (page 1)

As to claim 13, Valex does not explicitly disclose The method of claim 12 wherein publishing comprises including the list in a catalog of prospective customer lists available on the database.

However, Netcreations discloses including the list in a catalog of prospective customer lists available on the database (i.e. more than 3000 lists).). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Netcreations within Valex for the motivation of offering automated realtime list availability to list purchasers (page 1)

As to claim 14, Valex does not explicitly disclose The method of claim 1, further comprising determining usage instructions for the customer list, the usage instructions controlling the distribution and use of the customer list by a purchaser of the list from the database

However, Netcreations discloses determining usage instructions for the customer list, the usage instructions controlling the distribution and use of the customer list by a purchaser of the list from the database (i.e. purchase lists)(page 1). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Netcreations within Valex for the motivation of offering automated realtime list availability to list purchasers (page 1)

As to claim 15, Valex does not explicitly disclose The method of claim 14, wherein the usage instructions for the customer list are received from the client system.

However, Netcreations discloses determining usage instructions for the customer list, the usage instructions controlling the distribution and use of the customer list by a purchaser of the list from the database (i.e. purchase lists)(page 1). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Netcreations within Valex for the motivation of offering automated realtime list availability to list purchasers (page 1)

As to claim 16, Valex and Netcreations does not explicitly disclose The method of claim 14, wherein the usage instructions restrict the purchase of the customer list from the database to specific list purchasers.

However, the Examiner takes official notice that it was well known in the targeted marketing and advertising arts to restrict services to particular purchasers. The motivation was to provide targeted marketing to customer segments and not overwhelm individual customers with random unwanted or undesired solicitations. It would have been obvious to one of ordinary skill in the arts at the time of Applicant's invention to

Art Unit: 3626

include the aforementioned limitation within Valex and Netcreations for the motivation stated above.

As to claim 19, Valex does not explicitly disclose The method of claim 1, further comprising determining the pricing instructions for the list, the pricing instructions specifying the cost of the list to a purchaser of the list from the database.

However, Netcreations discloses determining the pricing instructions for the list, the pricing instructions specifying the cost of the list to a purchaser of the list from the database (i.e. mailings cost 10 to 20 cents a name)(page 1). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Netcreations within Valex for the motivation of offering automated realtime list availability to list purchasers (page 1

As to claim 20, Valex does not explicitly disclose The method of claim 19, wherein the pricing instructions are received from the client system.

However, Netcreations discloses wherein the pricing instructions are received from the client system (page 1). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Netcreations within Valex for the motivation of offering automated realtime list availability to list purchasers (page 1)

As to claim 41, Valex discloses The method of claim 1, further comprising: receiving a request from the client system to update the list (Fig. 2-4, pages 2-6 –2-8), retrieving the list from the database (Fig. 2-4, pages 2-6 –2-8),

receiving modified data for the list from a location on the computer network (Fig. 2-4, pages 2-6 –2-8)

updating the list to include the modified data (Fig. 2-4, pages 2-6 –2-8), and storing the updated list in the database (Fig. 2-4, pages 2-6 –2-8).

As to claim 42, Valex discloses The method of claim 41, wherein the request from the client system identifies the location of the modified data on the computer network (Fig. 2-4, pages 2-6 –2-8).

As to claim 43, Valex discloses The method of claim 41, wherein the modified data comprises modified prospect data and updating comprises replacing the initial prospect data with the modified prospect data (Fig. 2-4, pages 2-6 –2-8).

As to claim 44, Valex discloses The method of claim 43, wherein the initial prospect data is completely replaced by the modified prospect data (Fig. 2-4, pages 2-6 –2-8).

As to claims 21-28, 32-34, 36, 39 and 40, the claims are substantially similar in scope to claims 1-8, 12-14, 16, 19 and 20 and are rejected on the same basis.

Response to Arguments

5. Applicant's arguments with respect to the Examiner's notice of non-compliant amendment, particularly to the status of Withdrawn currently amended claims is persuasive and the Examiner withdraws the objection to the status of the withdrawn-currently amended claims 29-31, 37, 47 and 49.

Art Unit: 3626

6. The Examiner notes that Applicant did not respond to the requirement to cancel non-elected claims 50-72 which was established in the office action dated 6/15/2004 on page 4. This application contains claims 50-72 drawn to an invention nonelected with traverse in Paper No. dated 4/8/2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Pat No. 5,930,764 discloses a sales and marketing support system.
- b. Pat. No. 6,167,435 discloses a system for generating electronic mail subscription address lists.
- c. Pat. No. 5,636,346 discloses targeting advertisements.
- d. "What does it all mean to you?" discloses buying or renting lists.
- e. "List-Universe launches Business Resource network ..." discloses development of a business to business email list network.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

Art Unit: 3626

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.

A handwritten signature in black ink, appearing to read "Alexander Kalinowski". The signature is fluid and cursive, with a large, sweeping initial "A".

Alexander Kalinowski

Primary Examiner

Art Unit 3626

4/3/2005